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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,040

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Takeshi Kodu

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EXAMINER

TEKLE, DANIEL T

ART UNIT

PAPER NUMBER

2621

NOTIFICATION DATE

DELIVERY MODE

09/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,040	<b>Applicant(s)</b> KODA ET AL.	
	<b>Examiner</b> DANIEL TEKLE	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8, 10 and 12 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, “An information record/reproduction method, which is for recording information into an information record medium in a non-transitory state, comprising: a first record process and a reading process” steps is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-5 and 7-15 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-5 and 7-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Mizumura et al. (US 2002/0001453) and further in view of Kato et al. (US 7,738,776).

**Regarding Claim 1:** Mizumura et al. and Kato et al. discloses an information record medium on which there are recorded in a non-transitory state: an object data file for storing a object which includes a video stream having a main-video (paragraph 0033: the OSD data generator 19 generates OSD data corresponding to a character string that should be displayed as part of video [Mizumura et al.]) and a sub-picture stream having a sub-picture (paragraph 0034: sub-video data outputted from the sub-video processor 16 c); a play list information file (Figure 29: Global time axis of Playlist [Kato et al.]) for storing play list information which includes a plurality of item information (Figure 29: Previous PlayItem and Current Playitem with IN time and Out time [Kato et al.]) each of which indicates a reproduction unit of the object data (Figure 29: In time[PTS] and Out time [PTS] [Kato et al.]); and an object information file for storing object information which indicates an address of the object data which is indicated by each of the plurality item information (Figure 32: PlayItem information as list on the table [Kato et al.]), wherein the sub-picture stream includes sub-picture information (paragraph 0033: The OSD data information displayed on a screen,

which include information about management of reproduction information, such as the title and chapters of a disc [Mizumura et al.]), which indicates the sub-picture displayable at least partially over the main-video (Figure 4A element 32a [Mizumura et al.]), and sub-picture control information (paragraph 0033: Under instructions from the system controller 11, the OSD data generator 19 generates OSD data corresponding to a character string that should be displayed as part of video [Mizumura et al.]), the sub-picture control information includes (i) sub-frame control information to control displaying sub-frame which forms one portion of the sub-picture (paragraph 0044: OSD title generator 19 to generate OSD data indicative of title information and chapter information [Mizumura et al.]), (ii) identification information to indicate the sub-picture information which is a control target by the sub-frame control information (paragraph 0044: Positions for displaying the OSD character [Mizumura et al.]), (iii) sub-frame display position information to indicate a display position of the sub-frame (paragraph 0044: Positions for displaying the OSD character [Mizumura et al.]), (iv) cut out range information to indicate a range of the sub-picture which forms the sub-frame by cutting-out one portion of the sub-picture (paragraph 0044: Positions for displaying the OSD character [Mizumura et al.]), (v) button number information to indicate the number of button which is formed by the sub-frame (Figure 4B: [Mizumura et al.]), (vi) button state information to indicate an initial button state of the button (Figure 6a element 32a: [Mizumura et al.]), and (vii) command information to indicate a command which is to be performed in accordance with the button (Figure 6a element 32a [Mizumura et al.]), wherein the sub-frame

control information includes dynamic control information to display dynamically the sub-frame (**paragraph 0006 and 0008 the sub-video [Mizumura et al.]**).

Mizumura et al. discloses all the claim limitation, except play list and play item information as shown above; however Kato et al. discloses playlist and play item information as cited above.

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine the teachings of Kato et al., directed toward playlist and play item information, into the system taught by Mizumura et al., because such a combination would provide in-point and out-point information for sub-video frames thus allowing for said video to be segmented and more easily managed.

**Regarding Claim 2:** Mizumura et al. and Kato et al. discloses an information record medium according to claim 1, further Mizumura et al. discloses wherein the dynamic control information includes information to change dynamically at least one of a display position, a display size and a display shape of the sub-frame to be displayed over the main-video (**Fig. 4a-c and fig. 5a-c**).

**Regarding Claim 3:** Mizumura et al. and Kato et al. discloses an information record medium according to claim 1, further Mizumura et al. discloses wherein the dynamic control information includes information to change dynamically a display content within the sub-frame whose display position, display size and display shape are fixed relative to the main-video (**Fig. 4a-c and fig. 5a-c**).

**Regarding Claim 4:** Mizumura et al. and Kato et al. discloses an information record medium according to claim 1, further Mizumura et al. discloses wherein the sub-frame display position information designates a rectangular area as the sub-picture (**fig. 4a-c and fig. A-c**), the rectangular area occupying a part of the sub-picture (**Fig. 4a-c and fig. 5a-c**), and the dynamic control information has information to change dynamically the display content within the sub-frame by changing the rectangular area designated by the sub-frame display position information relative to the sub-picture (**Fig. 4a-c: element 32a, 32b and 32c and fig. 5a-c: element 32a, 32b and 32c**).

**Regarding Claim 5:** Mizumura et al. and Kato et al. discloses an information record medium according to claim 1, further Mizumura et al. discloses wherein the dynamic control information has information to display dynamically the sub-frame in such a manner that the sub-frame moves two-dimensionally or three-dimensionally relative to the main-video (**Fig. 4a-c and fig. 5a-c**).

**Regarding Claim 7-8:** Claim 7-8 rejected for similar reason to claim 1 as discussed above.

**Regarding Claim 9:** Claim 9 rejected for similar reason to claim 1-3 as discussed above.

**Regarding Claim 10:** Claim 10 rejected for similar reason to claim 1-3 as discussed above.

**Regarding Claim 11:** Claim 11 rejected for similar reason to claim 1-3 as discussed above.

**Regarding Claim 12:** Claim 12 rejected for similar reason to claim 1-3 as discussed above.

**Regarding Claim 13:** Claim 13 rejected for similar reason to claim 1-3 as discussed above.

**Regarding Claim 14:** Claim 14 rejected for similar reason to claim 1-3 as discussed above.

**Regarding Claim 15:** Claim 15 rejected for similar reason to claim 1-3 as discussed above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel Tekle/  
Examiner, Art Unit 2621

/Peter-Anthony Pappas/  
Supervisory Patent Examiner, Art Unit 2621